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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,219	04/26/2001	Shunpei Yamazaki	12732-032001 / US4867	5375
26171 7590 06/11/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HENNING, MATTHEW T	
			ART UNIT 2131	PAPER NUMBER
			MAIL DATE 06/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/842,219

Applicant(s)

YAMAZAKI ET AL.

Examiner

Matthew T. Henning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,26 and 51-83 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,26 and 51-83 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

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1 This action is in response to the communication filed on 3/26/2007.

2 **DETAILED ACTION**

3 ***Response to Arguments***

4 Applicants' arguments filed 3/26/2007 have been fully considered but they are not  
5 persuasive.

6 Applicants' argument that Li does not describe a **nonvolatile** memory for storing  
7 reference biological information of the client using the mobile telephone, is moot in view of the  
8 new grounds of rejection in view Li and Nagayoshi.

9 In response to applicant's argument that there is no suggestion to combine the references,  
10 Li and Osborn, the examiner recognizes that obviousness can only be established by combining  
11 or modifying the teachings of the prior art to produce the claimed invention where there is some  
12 teaching, suggestion, or motivation to do so found either in the references themselves or in the  
13 knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,  
14 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.  
15 1992). In this case, the motivation to combine comes from the knowledge generally known to  
16 one of ordinary skill in the art at the time of invention. As such, the argument is not persuasive.  
17 However, the examiner is withdrawing the rejection in view of the combination in favor of the  
18 rejection in view of Li and Nagayoshi, which was necessitated by the claim amendments.  
19 Furthermore, see the recent decision by the Supreme Court of the United States *KSR*  
20 *INTERNATIONAL CO. v. TELEFLEX INC. ET AL.*

21 Regarding applicants' remarks that the basis for the prior art rejection of claim 83 was  
22 not provided in the office action dated 11/28/2006, the examiner notes that by typographical

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error, the statement of the grounds of rejection read "Claims 1, 26, 51, 54-60, and 62-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li." where "82" should have read "83". This is further clear as the rejection of claim 83 was detailed under this grounds of rejection on Page 6 of the office action.

Claims 1, 26, 51, and 54-83 have been examined. Claims 2-25, 27-50, and 52-53 have been cancelled.

All objections and rejections not set forth below have been withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 26, 51, and 54-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li, and further in view of Nagayoshi et al. (US Patent Number 6,839,798) hereinafter referred to as Nagayoshi.

Regarding claims 1 and 26, Li disclosed a system for identifying a client (See Li Abstract), the system comprising a server and a portable communication device, wherein the portable communication device comprises: a memory for storing at least one reference biological information of the client using the portable communication device (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element 417); a checking circuit for checking the read

1 biological information with the stored biological information (See Li Fig. 4 Element 401 and  
2 Col. 12 Lines 8-36); and a transmitting circuit for transmitting information that the read  
3 biological information and the stored biological information have matched to the server in a case  
4 where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9),  
5 wherein the server is configured to transmit the information that the read biological information  
6 and the stored biological information have matched to a final end of transaction configured to  
7 start a transaction with the client conditioned upon receipt of the information that the read  
8 biological information and the stored biological information have matched (See Li Col. 16  
9 Paragraph 2), but Li failed to specifically disclose that memory 404 was a nonvolatile memory.  
10 However, Li did disclose that the portable communication device could be a phone (See Li Fig.  
11 1), and that the memory 404 stored at least those items necessary to the operation of the  
12 fingerprint capturing device including program code for processing, as well as temporary data (  
13 See Li Col. 12 Lines 20-27).

14 Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See  
15 Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as  
16 rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col.  
17 1 Lines 6-18).

18 It would have been obvious to the ordinary person skilled in the art at the time of  
19 invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the  
20 flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because  
21 the ordinary person skilled in the art would have been motivated to provide the needed memory  
22 to Li in a small packaging area at a small cost.

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1           Regarding claim 51, Li disclosed a business method using the Internet, said business  
2 method comprising: identifying a client by an identifying element loaded in a portable  
3 communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a  
4 communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a  
5 control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying  
6 comprises: storing a reference biological information of the client in a memory in the portable  
7 communication device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines  
8 20-27); reading biological information of the client (See Li. Col. 10 Lines 57-58); checking the  
9 read biological information with the reference biological information (See Li Col. 10 Lines 61-  
10 65); and transmitting information that the read biological information and the reference  
11 biological information have matched from the identifying element to the control element in a  
12 case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-  
13 9), and wherein said controlling step comprises: admitting the communication between the client  
14 and the plurality of dealers after identifying the client by the identifying element (See Li Col. 11  
15 Lines 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56), and wherein  
16 the server is configured to transmit the information that the read biological information and the  
17 stored biological information have matched to a final end of transaction configured to start a  
18 transaction with the client conditioned upon receipt of the information that the read biological  
19 information and the stored biological information have matched (See Li Col. 16 Paragraph 2),  
20 but Li failed to specifically disclose that memory 404 was a nonvolatile memory. However, Li  
21 did disclose that the portable communication device could be a phone (See Li Fig. 1), and that  
22 the memory 404 stored at least those items necessary to the operation of the fingerprint capturing

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1 device including program code for processing, as well as temporary data ( See Li Col. 12 Lines  
2 20-27).

3 Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See  
4 Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as  
5 rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col.  
6 1 Lines 6-18).

7 It would have been obvious to the ordinary person skilled in the art at the time of  
8 invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the  
9 flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because  
10 the ordinary person skilled in the art would have been motivated to provide the needed memory  
11 to Li in a small packaging area at a small cost.

12 Regarding claim 83, Li disclosed a system for identifying a client, said system  
13 comprising: a server (See Li Fig. 1 Element 106); a storing means comprising memory for  
14 storing reference biological information of the client (See Li Fig. 4 Element 404); a reading  
15 means for reading biological information of the client (See Li Fig. 4 Element 101); a checking  
16 means for checking the read biological information with the reference biological information  
17 (See Li Col. 10 Lines 61-65); a transmitting means for transmitting information that the read  
18 biological information and the reference biological information have matched to the server in a  
19 case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-  
20 9); a final end of transaction (See Li Fig. 3B Step 319 Recipient and Col. 16 Paragraph 2); a  
21 further transmitting means for transmitting said information that the read biological information  
22 and the reference biological information have matched from the server to the final end of

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1 transaction with the client (See Li Fig. 3B Step 319 and Col. 16 Paragraph 2); and a transaction  
2 starting means for starting a transaction between the client and the final end of transaction after  
3 the final end of transaction has received said information that the read biological information and  
4 the reference biological information have matched (See Li Fig. 3B Steps 316 and 319 and Col.  
5 16 Paragraph 2), but Li failed to specifically disclose that memory 404 was a nonvolatile  
6 memory. However, Li did disclose that the portable communication device could be a phone  
7 (See Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of  
8 the fingerprint capturing device including program code for processing, as well as temporary  
9 data ( See Li Col. 12 Lines 20-27).

10 Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See  
11 Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as  
12 rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col.  
13 1 Lines 6-18).

14 It would have been obvious to the ordinary person skilled in the art at the time of  
15 invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the  
16 flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because  
17 the ordinary person skilled in the art would have been motivated to provide the needed memory  
18 to Li in a small packaging area at a small cost.

19 Regarding claims 54 and 66, Li and Nagayoshi disclosed that the memory stores a  
20 plurality of biological information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph  
21 3 and Col. 10 Paragraph 4), and the transmitting circuit transmits information that the read

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1 biological information has matched with at least one of the stored plurality of information to the  
2 server (See Li Col. 11 Lines 3-9).

3 Regarding claims 55 and 67, Li and Nagayoshi disclosed that the sensor reads a plurality  
4 of biological information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit  
5 transmits information that each of the plurality of read biological information has matched with  
6 at least one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

7 Regarding claims 56 and 68, Li and Nagayoshi disclosed that the information that the  
8 read biological information and the stored biological information have matched is transmitted to  
9 the server through the Internet (See Li Col. 7 Paragraph 2).

10 Regarding claims 57 and 71, Li and Nagayoshi disclosed that after transmitting  
11 information that the checking has matched to the server, a personal identification number  
12 information is sent to the Server (See Li Col. 15 Paragraphs 3-4).

13 Regarding claims 58 and 72, Li and Nagayoshi disclosed that in a case that the personal  
14 identification number matches with a number stored at the server, the stored biological  
15 information is rewritable (See Li Col. 15 Paragraph 3).

16 Regarding claims 59-60, 73-74, and 78-79, Li and Nagayoshi disclosed that the  
17 biological information is one selected from the group consisting of a fingerprint, a palm pattern  
18 and a voice print; and that the palm pattern is a whole pattern of the palm or a pattern of a part of  
19 the palm (See Li Col. 6 Paragraph 3 and Col. 17 Paragraph 3).

20 Regarding claim 61, Li and Nagayoshi disclosed that the memory includes a flash  
21 memory (See the rejection of claim 1 above).



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1 however, will the statutory period for reply expire later than SIX MONTHS from the date of this  
2 final action.

3 Any inquiry concerning this communication or earlier communications from the  
4 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.

5 The examiner can normally be reached on M-F 8-4.

6 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
7 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the  
8 organization where this application or proceeding is assigned is 571-273-8300.

9 Information regarding the status of an application may be obtained from the Patent  
10 Application Information Retrieval (PAIR) system. Status information for published applications  
11 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
12 applications is available through Private PAIR only. For more information about the PAIR  
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15 like assistance from a USPTO Customer Service Representative or access to the automated  
16 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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23 /Matthew Henning/  
24 Assistant Examiner  
25 Art Unit 2131  
26 6/6/2007

  
**AYAZ SHEIKH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**